

REMARKS

Support for the amendment of claim 1, claim 6 and claim 31 may be found in Applicants' specification; specifically, at page 10, lines 1-5 and at page 18, lines 16-18. No new matter has therefore been introduced.

In the 11/30/2004 Office Action, the Examiner has rejected claims 1-6, 8-15 and 17-31 pending in the application. After entry of the preceding amendments, claims 1-4, 6, 8-15 and 17-31 are pending in the application. Reconsideration of previously pending claims 1-4, 6, 8-15 and 17-31 and allowance of all claims 1-4, 6, 8-15 and 17-31 is respectfully requested.

35 U.S.C. §102

Claims 1-6, 8 and 9 have been rejected under 35 U.S.C. 102 as being anticipated by Kaplan (U.S. Patent No. 5,047,232). The Examiner has asserted that Kaplan teaches a non-aqueous waterproof oil-based composition which may be used as a delivery vehicle for sunscreens, as well as a method for preparing the sunscreen (col. 1, lines 7-14). The Examiner further asserts that Kaplan teaches the use of jojoba, lanolin, coconut, olive, liquid lanolin and cottonseed oils, which the Examiner has denominated "suitable cosmetic emollients" (col. 3, lines 49-54). The Examiner also suggests that Kaplan teaches (in the Examiner's words) "semi-solid cosmetic emollients [including] hydrogenated lanolin, petrolatum, isopropyl lanolate, butyl myristate, cetyl myristate, cetyl alcohol and isocetyl lanolate" citing Kaplan at col. 4, lines 12-20. The Examiner then acknowledges that the cited Kaplan reference is silent with respect to the teaching of temperature range and thereafter again asserts that Kaplan teaches a "semi-solid emollient". The Examiner thereafter proposes that Kaplan "meets the claims of the instant application".

Notwithstanding Applicant's instant amendment of claim 1, the Examiner's assertion that Kaplan teaches the use of semi-solid emollients (presumably in the context of topical application) at col. 3, lines 49-54 and col. 4, lines 12-20 is incorrect. In appreciation of the difficulty of delivering solid and semi-solid formulations, Kaplan states at column 4, lines 12-15 that "solid or semi-solid" compounds may be used in accordance with Kaplan's invention "*if admixed with mineral oil in amounts sufficient to provide liquid topical compositions*" (emphasis added). Indeed, skilled artisans would be left to conclude that "solid or semi-solid" compounds may *only* be used in accordance with Kaplan's teaching if mixed with a liquid thinning agent in order to render the resulting mixture capable of being dispensed and applied in

accordance with the teaching and disclosure of Kaplan (*i.e.*, “liquid topical composition[s]”; *see, for example*, Kaplan at column 4, lines 12-15). Accordingly, topical application of a semi-solid emollient, as disclosed and claimed in Applicants’ instant application, would render the invention of Kaplan inoperable for its intended purpose – namely, the topical application of sunscreen compositions capable of being dispensed and delivered in liquid phase.

As the Examiner is aware, in order for a reference to anticipated the instant invention, the cited reference “must contain all the elements, or their [equivalents], in the same description, method or device combined in substantially the same way to produce substantially the same result as that accomplished by the disclosure of the patent in suit.” *McLemore v. Southern Impliment Mfg. Co., Inc.*, DC, ND Miss. 141 USPQ 7 (1964). Furthermore, “each claim must be embodied in a single prior art reference, which must contain adequate directions for practice of the claim; additionally, elements must perform substantially the same function in substantially the same way to achieve substantially the same result in prior art and the claimed invention. *Antici V. KBH Corp.*, DC, ND Miss., 168 USPQ 745 (1971).

Quite simply, Kaplan does not teach or otherwise disclose a “cuticle treatment and conditioning composition”, much less “a semi-solid emollient having esterified compounds at least partially derived from [...] natural seed and nut oils”.

In the context of newly amended claim 1, the discussion with respect to additional compositional components including dyes, colorants, perfumes and antioxidants is irrelevant. Also in the context of claim 1 as amended, the discussion with respect to temperature ranges is likewise irrelevant.

Irrespective of temperature ranges or additional compositional components, nowhere does Kaplan teach or disclose a “cuticle treatment and conditioning composition” in accordance with Applicants’ claim 1 as amended. Furthermore, Kaplan does not teach or disclose a semi-solid emollient comprising esterified components at least partially derived from natural seed or nut oils. Accordingly, the Kaplan reference cannot be considered to meet each and every element of claim 1 as amended. Applicants therefore respectfully request that the Examiner withdraw the § 102(b) rejection of claim 1 as amended.

Inasmuch as claims 2-4, 6, 8 and 9 depend from, further limit and incorporate all of the elements and limitations of claim 1, these claims are also allowable over the Kaplan reference. Applicants therefore submit that claims 2-4, 6, 8 and 9 are allowable and respectfully request that the Examiner withdraw the § 102(b) rejections of the same.

35 USC § 103(a)

At page 5 of the pending Office Action, the Examiner purports to establish a “*prima facie*” case for obviousness. As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations (*see* MPEP, 2143). Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-4, 6, 8-15 and 17-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arquette (U.S. Patent No. 5,968,530) in view of Miller (U.S. Patent No. 4,286,609). Applicants respectfully traverse.

The Examiner asserts that Arquette teaches an emollient composition produced from fatty alcohols, isopropyl esters and wax esters. The Examiner further asserts that Arquette teaches emollient compositions that may be used as carriers. The Examiner also proposes that Arquette teaches the use of additives such as fragrances, pigments, antimicrobial agents, antibacterial materials, pheromones, anti-inflammatory agents, sun blocks, sun screens and insect repellants. The Examiner also asserts that Arquette discloses a process for making an emollient using the steps of providing jojoba oil, adding an alcohol, effecting alcoholysis of the oil, and effecting interesterification of the remaining wax esters. Even if true, the Examiner’s assertions are irrelevant for reasons discussed *vide infra*.

The Examiner acknowledges that Arquette does not teach a container for retaining an emollient composition.

The Examiner asserts that Miller teaches a fingernail and cuticle treatment using a bottle containing “the inventive mixture” that may be used as a hot oil treatment; however, Applicants are affirmatively unaware of what the Examiner intends to reference using the phrase “the inventive mixture”. Does the Examiner intend to reference the technology embodied in the Arquette reference? Does the Examiner intend to reference the technology embodied in the Miller reference? Does the Examiner intend to reference the technology corresponding to the Applicants’ invention? Does the Examiner intend to reference some

combination of elements found in Arquette and Miller? If so, which elements? Applicants respectfully request clarification on this point. Notwithstanding the preceding, Applicants shall assume for the purpose of entering this Response that “the inventive mixture” is intended to reference the compositional components disclosed in the Miller reference as identified in Miller at column 2, line 3.

The Examiner asserts that the Miller reference discloses a cylindrical container for use with hot oil cuticle treatments using animal and vegetable oils, proteins, vitamins and other ingredients. The Examiner further proposes that the act of dispensing the hot oil treatment composition past an opening in a cylindrical container or “extruding” the hot oil composition past the opening and replacing the cap on the container would be obvious to skilled artisans. Even if true, the Examiner’s assertions with respect to the Miller reference are irrelevant; however, notably and significantly, the cylindrical container of Miller corresponds to a liquid storage bottle 26 depicted in Figures 1 and 3, and not an applicator adapted to deliver a semi-solid extrudate.

Applicants are affirmatively unaware as to why the Examiner would choose to use the phrase “extruding” in the context of the oil treatment disclosed by Miller (even if taken in combination with the Arquette reference). Skilled artisans appreciate that ‘extrusion’ generally refers to the process of forcing or drawing a material out of a containment reservoir in a manner that permits a suitably adapted material (e.g., a semi-solid composition) exiting the reservoir opening to effectively conform to the shape of the opening. See, for example, Merriam-Webster’s Dictionary online (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=extruding>) and The American Heritage Dictionary, Second College Edition, 1985, Houghton Mifflin Company, Boston.

It should be noted that any combination of the elements of Miller and Arquette would not produce a material capable of satisfying the requirements of an extrudate. Specifically, a liquid oil (as disclosed in Miller) would not conform and retain its shape upon pouring from storage bottle 26. One of the definitional requirements of a ‘liquid’ is that such a material must flow and move to conform to the shape of a receiving or containment volume. *See, for example*, Merriam-Webster’s Dictionary online (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=liquid>), where a liquid is defined as:

“[noun:] a fluid (as water) that has no independent shape but has a definite volume and does not expand indefinitely and that is only slightly compressible”

Semi-solid extrudates, on the other hand, do demonstrate independent shape corresponding to the geometry of the dispensing opening. If given the compositions of toothpaste and mouthwash and told to assign them to a category corresponding to either 'liquid' or 'semi-solid' states of matter, skilled artisans would be able to make the same classification no doubt clearly evident to the Examiner. Accordingly, Applicants respectfully request that the Examiner replace the word "extruding" at page 5, line 4 of the pending Office Action with a more appropriate word corresponding to delivery of a liquid, such as, for example: "decanting" or "pouring" in keeping with the disclosure of Miller. *See also, for example, Figure 3 in Miller*, which clearly depicts the action of decanting or pouring a liquid.

Applicants submit that the combination of Arquette and Miller does not teach or suggest a "cuticle treatment and conditioning composition [...] comprising a semi-solid emollient having esterified compounds at least partially derived from [...] natural seed and nut oils" as set forth in claim 1 as amended. Additionally, there is no motivation or suggestion to be found in either the Arquette or the Miller reference, nor in the knowledge generally available to one of ordinary skill in the art, to modify Arquette or Miller or to combine either reference with each other, or any other reference of record, to practice the invention of claim 1 as amended.

The Examiner proposes that "[t]he idea of combining them flows logically from their having been individually taught in the prior art", citing *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). As the Examiner is aware however, any basis for rejecting claims utilizing general knowledge, common sense or 'logical ideas' that originate with the Examiner, and not in the references themselves or the knowledge generally available to skilled artisans, is impermissible. Specifically, "with respect to core factual findings in a determination of patentability, [the Examiner] cannot simply reach conclusions based on [his/her] own understanding or experience – or on [his/her] assessment of what would be basic knowledge or common sense. Rather [the Examiner] must point to some concrete evidence in the record in support of [the] findings." *In re Zurko*, 258 F.3d 1379 (2001). Applicants respectfully request that the Examiner provide concrete evidence in the record in support of the Examiner's findings with regard to the motivation to combine the cited references.

With respect to the *Zurko* requirements, the 'logical idea' occurring to the Examiner at page 5, lines 3-6 is impermissible for establishing the required motivation to combine under the first element established in MPEP 2143. Accordingly, the Arquette and Miller reference may not be properly cited against Applicants' application under § 103(a). Applicants therefore respectfully request that the § 103(a) rejection of claim 1 as amended be withdrawn.

Additionally, under the second element established under MPEP 2143, since there is no motivation or suggestion to combine either reference with each other (or with any other reference of record), there can be no expectation of success at all, much less a “reasonable” expectation of success. Any expectation of success, absent a motivation or suggestion to combine, would be unreasonable at best. Accordingly, claim 1 may not properly be considered as obvious under § 103(a). Applicants therefore respectfully request that the § 103(a) rejection of claim 1 as amended be withdrawn.

Notwithstanding the preceding discussion, even if the teaching of Arquette were to be combined with the teaching of Miller, the resulting combination would not correspond to Applicants’ invention as embodied in claim 1 as amended. Specifically, the combination of Arquette with Miller does not disclose, teach or otherwise suggest a “cuticle treatment and conditioning composition [...] comprising a semi-solid emollient having esterified compounds at least partially derived from [...] natural seed and nut oils” (emphasis added). It is important to note that the Examiner has not identified (in either reference) any suggestion that a semi-solid emollient comprising esterified compounds may be used for cuticle treatment. Furthermore, it is important to note that the cuticle stick that the Examiner references in Miller at column 2, lines 3-23 is not adapted for containment and delivery of a semi-solid composition. The cuticle stick 16 referenced by the Examiner at page 4, lines 19-20 of the pending Action, appears in Figure 1 of Miller. Miller’s cuticle stick 16 in Figure 1 is a conventional cuticle stick that has been commercially available for several decades. The cuticle stick 16 disclosed by Miller is used solely for pushing back the user’s cuticles, not storing or delivering a cuticle treatment preparation. This is further illustrated in Miller’s Figure 6, where the action of the user pushing back their cuticles with the soft rubber tip 34 of stick 16 is depicted in conjunction with the prior step of ‘fingertip soaking’ taught by Miller. Note also in Figure 3 of Miller that the fingertip soaking solution contained in storage bottle 26 is “poured” (*i.e.*, in liquid phase) from the containment vessel 26 into the receiving area 12 for subsequent fingertip soaking. Accordingly, the combination of Arquette with Miller would suggest that suitable emollient compositions for use with cuticle treatments (resulting from the proposed combination of the two references) would occur in liquid phase. If this were not the case, the technology disclosed by Miller would not operate for its intended purpose; namely, providing a fingertip soak.

At page 4, lines 14-15 of the pending Action, the Examiner acknowledges that Arquette does not teach a container that retains a semi-solid emollient – ostensibly, thereafter looking to the Miller reference to provide this missing feature (*i.e.*, constructing an argument along the lines of ‘Arquette purportedly has the compositional material’ and ‘Miller purportedly has the delivery device’). The Examiner then

proposes at page 5, lines 7-10 of the pending Action that both references teach separate compositions that may be combined in order to obtain a third composition corresponding to Applicant's invention (*e.g.*, constructing an argument along the lines of 'Arquette purportedly has a first compositional component of the material' and 'Miller purportedly has the second missing compositional component'). Applicants request clarification as to what the Examiner intends to communicate in the pending Action. Is the Examiner suggesting that Applicants' cuticle treatment compound is compositionally disclosed entirely in the Arquette reference, or that Applicants' cuticle treatment compound is compositionally disclosed as a combination of component parts separately found in the Arquette and the Miller reference? Respectfully, the Examiner cannot have it both ways.

The confusion concerning the combination proposed by the Examiner is further complicated at page 5, lines 12-16 of the pending Action, where the Examiner appears to revert back to an argument that 'Arquette purportedly discloses the compositional material' and 'Miller purportedly discloses the delivery device'. In this context, does the phrase "third composition" used by the Examiner at page 5, line 14 of the pending Action refer to the compositional material of Arquette contained in the container (which notably is not an applicator designed for topical delivery, but rather a storage bottle 26 as depicted in Figures 1 and 3) of Miller? Applicants respectfully request clarification on this point.

Notwithstanding the preceding confusion as to what the Examiner intends to communicate, even if the teaching of Arquette were to be combined with the teaching of Miller, the resulting combination would not correspond to Applicants' invention as embodied in claim 1 as amended. Specifically, the combination of Arquette with Miller does not disclose, teach or otherwise suggest a "cuticle treatment and conditioning composition [...] comprising a semi-solid emollient having esterified compounds at least partially derived from [...] natural seed and nut oils" (emphasis added). Furthermore, the Arquette and Miller references may not be properly combined since there is nothing in their disclosures that would teach combination or any reason for it; moreover, the combination of the proposed references would destroy the inventive technology disclosed in the Miller reference for its intended purpose as discussed *vide supra*. See, for example, *Ex parte Sternau*, 155 USPQ 733 (POBA 1967). Accordingly, Applicants respectfully request that the Examiner withdraw the § 103(a) rejection of claim 1 as amended.

Inasmuch as claims 2-4, 6, 8 and 9 depend from, further limit and incorporate all of the elements and limitations of claim 1 as amended, these claims are also allowable over the cited references. Applicants therefore submit that claims 2-4, 6, 8 and 9 are allowable and respectfully request that the Examiner withdraw the § 103(a) rejections of the same.

Applicants submit that the combination of Arquette and Miller does not teach or suggest a “product for treating cuticles [...] comprising [...] a semi-solid emollient [...] and a container that retains the semi-solid emollient and enables the user to apply the emollient to a selected surface without the user having to touch the emollient with his/her finger tips” as set forth in claim **10**. Additionally, there is no motivation or suggestion to be found in either the Arquette or the Miller reference, nor in the knowledge generally available to one of ordinary skill in the art, to modify Arquette or Miller or to combine either Arquette or Miller with each other, or any other reference of record, to practice the invention of claim **10**.

The Examiner proposes that “[t]he idea of combining them flows logically from their having been individually taught in the prior art”, citing *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). As the Examiner is aware however, any basis for rejecting claims utilizing general knowledge, common sense or ‘logical ideas’ that originate with the Examiner, and not in the references themselves or the knowledge generally available to skilled artisans, is impermissible. Specifically, “with respect to core factual findings in a determination of patentability, [the Examiner] cannot simply reach conclusions based on [his/her] own understanding or experience – or on [his/her] assessment of what would be basic knowledge or common sense. Rather [the Examiner] must point to some concrete evidence in the record in support of these findings.” *In Re Zurko*, 258 F.3d 1379 (2001). Applicants respectfully request that the Examiner provide concrete evidence in the record in support of the Examiner’s findings with regard to the motivation to combine the cited references.

With respect to the *Zurko* requirements, the ‘logical idea’ occurring to the Examiner at page 5, lines 3-6 is impermissible for establishing the required motivation to combine under the first element established in MPEP 2143. Accordingly, the Arquette and Miller reference may not be properly cited against Applicants’ application under § 103(a). Applicants therefore respectfully request that the § 103(a) rejection of claim **10** be withdrawn.

Additionally, under the second element established under MPEP 2143, since there is no motivation or suggestion to combine either reference with each other (or with any other reference of record), there can be no expectation of success at all, much less a “reasonable” expectation of success. Any expectation of success, absent a motivation or suggestion to combine, would be unreasonable at best. Accordingly, claim **10** may not properly be considered as obvious under § 103(a). Applicants therefore respectfully request that the § 103(a) rejection of claim **10** be withdrawn.

Notwithstanding the preceding discussion, even if the teaching of Arquette were to be combined with the teaching of Miller, the resulting combination would not correspond to Applicants' invention as embodied in claim 10. Specifically, the combination of Arquette with Miller does not disclose, teach or otherwise suggest a "product for treating cuticles [...] comprising [...] a semi-solid emollient [...] and a container that retains the semi-solid emollient and enables the user to apply the emollient to a selected surface without the user having to touch the emollient with his/her finger tips" (emphasis added). It is important to note that the Examiner has not identified (in either reference) any suggestion that a semi-solid emollient compound may be used for cuticle treatment. Furthermore, it is important to note that the cuticle stick that the Examiner references in Miller at column 2, lines 3-23 is not adapted for containment and delivery of a semi-solid composition. For example, the cuticle stick 16 referenced by the Examiner at page 4, lines 19-20 of the pending Action, appears in Figure 1 of Miller. Miller's cuticle stick 16 in Figure 1 is a conventional cuticle stick that has been commercially available for several decades. The cuticle stick 16 disclosed by Miller is used solely for pushing back the user's cuticles. This is further illustrated in Miller's Figure 6, where the action of the user pushing back their cuticles with the soft rubber tip 34 of stick 16 is depicted. Note also in Figure 3 of Miller that the fingertip soaking solution contained in vessel 26 is "poured" (*i.e.*, in liquid phase) from the containment vessel 26 into the receiving area 12. Accordingly, the combination of Arquette with Miller would suggest that suitable emollient compositions for use with cuticle treatments (resulting from the proposed combination of the two references) would occur in liquid phase that would have to be touched by "soak[ing]" the fingertips (*see, for example*, the Abstract of the Miller reference). If this were not the case, the technology disclosed by Miller would not operate for its intended purpose; namely, providing a fingertip soak.

At page 4, lines 14-15 of the pending Action, the Examiner acknowledges that Arquette does not teach a container that retains a semi-solid emollient – ostensibly, thereafter looking to the Miller reference to provide this missing feature (*i.e.*, constructing an argument along the lines of 'Arquette purportedly has the compositional material' and 'Miller purportedly has the delivery device'). The Examiner then proposes at page 5, lines 7-10 of the pending Action that both references teach separate compositions that may be combined in order to obtain a third composition corresponding to Applicant's invention (*e.g.*, constructing an argument along the lines of 'Arquette purportedly has a first compositional component of the material' and 'Miller purportedly has the second missing compositional component'). Applicants request clarification as to what the Examiner intends to communicate in the pending Action. Is the Examiner suggesting that Applicants' cuticle treatment compound is compositionally disclosed entirely in the Arquette reference, or that Applicants' cuticle treatment compound is compositionally disclosed as a

combination of component parts separately found in the Arquette and the Miller reference? Respectfully, the Examiner cannot have it both ways.

The confusion concerning the combination proposed by the Examiner is further complicated at page 5, lines 12-16 of the pending Action, where the Examiner appears to revert back to an argument that ‘Arquette purportedly discloses the material’ and ‘Miller purportedly discloses the delivery device’. In this context, does the phrase “third composition” used by the Examiner at page 5, line 14 of the pending Action refer to the material of Arquette contained in the container (which is notably not an applicator designed for topical delivery, but rather a storage bottle **26** as depicted in Figures **1** and **3**) of Miller? Applicants respectfully request clarification on this point.

Notwithstanding the preceding confusion as to what the Examiner intends to communicate, even if the teaching of Arquette were to be combined with the teaching of Miller, the resulting combination would not correspond to Applicants’ invention as embodied in claim **10**. Specifically, the combination of Arquette with Miller does not disclose, teach or otherwise suggest a “product for treating cuticles [...] comprising [...] a semi-solid emollient [...] and a container that retains the semi-solid emollient and enables the user to apply the emollient to a selected surface without the user having to touch the emollient with his/her finger tips” (emphasis added). Furthermore, the Arquette and Miller references may not be properly combined since there is nothing in their disclosures that would teach combination or any reason for it; moreover, the combination of the proposed references would destroy the inventive technology disclosed in the Miller reference for its intended purpose as discussed *vide supra*. See, for example, *Ex parte Sternau*, 155 USPQ 733 (POBA 1967). Accordingly, Applicants respectfully request that the Examiner withdraw the § 103(a) rejection of claim **10**.

Inasmuch as claims **11-15** and **17-23** depend from, further limit and incorporate all of the elements and limitations of claim **10**, these claims are also allowable over the cited art. Applicants therefore submit that claims **11-15** and **17-23** are allowable and respectfully request that the Examiner withdraw the § 103(a) rejections of the same.

Applicants submit that the combination of Arquette and Miller does not teach or suggest a “method for treating a cuticle using a semi-solid emollient composition comprising the steps of providing a semi-solid emollient composition in a container and applying the semi-solid emollient composition on a selected area without touching the semi-solid emollient composition with any fingertips” as set forth in claim **24**. Additionally, there is no motivation or suggestion to be found in either the Arquette or the Miller

reference, nor in the knowledge generally available to one of ordinary skill in the art, to modify Arquette or Miller or to combine either Arquette or Miller with each other or any other reference to practice the invention of claim **24**.

The Examiner proposes that “[t]he idea of combining them flows logically from their having been individually taught in the prior art”, citing *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). As the Examiner is aware however, any basis for rejecting claims utilizing general knowledge, common sense or ‘logical ideas’ that originate with the Examiner, and not in the references themselves or the knowledge generally available to skilled artisans, is impermissible. Specifically, “with respect to core factual findings in a determination of patentability, [the Examiner] cannot simply reach conclusions based on [his/her] own understanding or experience – or on [his/her] assessment of what would be basic knowledge or common sense. Rather [the Examiner] must point to some concrete evidence in the record in support of these findings.” *In Re Zurko*, 258 F.3d 1379 (2001). Applicants respectfully request that the Examiner provide concrete evidence in the record in support of the Examiner’s findings with regard to the motivation to combine the cited references.

With respect to the *Zurko* requirements, the ‘logical idea’ occurring to the Examiner at page 5, lines 3-6 is impermissible for establishing the required motivation to combine under the first element established in MPEP 2143. Accordingly, the Arquette and Miller reference may not be properly cited against Applicants’ application under § 103(a). Applicants therefore respectfully request that the § 103(a) rejection of claim **24** be withdrawn.

Additionally, under the second element established under MPEP 2143, since there is no motivation or suggestion to combine either reference with each other (or with any other reference of record), there can be no expectation of success at all, much less a “reasonable” expectation of success. Any expectation of success, absent a motivation or suggestion to combine, would be unreasonable at best. Accordingly, claim **24** may not properly be considered as obvious under § 103(a). Applicants therefore respectfully request that the § 103(a) rejection of claim **24** be withdrawn.

Notwithstanding the preceding discussion, even if the teaching of Arquette were to be combined with the teaching of Miller, the resulting combination would not correspond to Applicants’ invention as embodied in claim **24**. Specifically, the combination of Arquette with Miller does not disclose, teach or otherwise suggest a “method for treating a cuticle using a semi-solid emollient” composition comprising the steps of providing a semi-solid emollient composition in a container and applying the semi-solid emollient

composition on a selected area without touching the semi-solid emollient composition with any fingertips” (emphasis added). It is important to note that the Examiner has not identified (in either reference) any suggestion that a semi-solid emollient compound may be used for cuticle treatment. Furthermore, it is important to note that the cuticle stick that the Examiner references in Miller at column 2, lines 3-23 is not adapted for containment and delivery of a semi-solid composition. For example, the cuticle stick 16 referenced by the Examiner at page 4, lines 19-20 of the pending Action, appears in Figure 1 of Miller. Miller’s cuticle stick 16 in Figure 1 is a conventional cuticle stick that has been commercially available for several decades. The cuticle stick 16 disclosed by Miller is used solely for pushing back the user’s cuticles. This is further illustrated in Miller’s Figure 6, where the action of the user pushing back their cuticles with the soft rubber tip 34 of stick 16 is depicted. Note also in Figure 3 of Miller that the fingertip soaking solution contained in vessel 26 is “poured” (*i.e.*, in liquid phase) from the containment vessel 26 into the receiving area 12. Accordingly, the combination of Arquette with Miller would suggest that suitable emollient compositions for use with cuticle treatments (resulting from the proposed combination of the two references) would occur in liquid phase that would have to be touched by “soak[ing]” the fingertips (*see, for example*, the Abstract of the Miller reference). If this were not the case, the technology disclosed by Miller would not operate for its intended purpose; namely, providing a fingertip soak.

At page 4, lines 14-15 of the pending Action, the Examiner acknowledges that Arquette does not teach a container that retains a semi-solid emollient – ostensibly, thereafter looking to the Miller reference to provide this missing feature (*i.e.*, constructing an argument along the lines of ‘Arquette purportedly has the compositional material’ and ‘Miller purportedly has the delivery device’). The Examiner then proposes at page 5, lines 7-10 of the pending Action that both references teach separate compositions that may be combined in order to obtain a third composition corresponding to Applicant’s invention (*e.g.*, constructing an argument along the lines of ‘Arquette purportedly has a first compositional component of the material’ and ‘Miller purportedly has the second missing compositional component’). Applicants request clarification as to what the Examiner intends to communicate in the pending Action. Is the Examiner suggesting that Applicants’ cuticle treatment compound is compositionally disclosed entirely in the Arquette reference, or that Applicants’ cuticle treatment compound is compositionally disclosed as a combination of component parts separately found in the Arquette and the Miller reference? Respectfully, the Examiner cannot have it both ways.

The confusion concerning the combination proposed by the Examiner is further complicated at page 5, lines 12-16 of the pending Action, where the Examiner appears to revert back to an argument that ‘Arquette purportedly discloses the compositional material’ and ‘Miller purportedly discloses the delivery device’. In this context, does the phrase “third composition” used by the Examiner at page 5, line 14 of the pending Action refer to the material of Arquette contained in the container (which is notably not an applicator designed for topical delivery, but rather a storage bottle 26 as depicted in Figures 1 and 3) of Miller? Applicants respectfully request clarification on this point.

Notwithstanding the preceding confusion as to what the Examiner intends to communicate, even if the teaching of Arquette were to be combined with the teaching of Miller, the resulting combination would not correspond to Applicants’ invention as embodied in claim 24. Specifically, the combination of Arquette with Miller does not disclose, teach or otherwise suggest a “method for treating a cuticle using a semi-solid emollient composition comprising the steps of providing a semi-solid emollient composition in a container and applying the semi-solid emollient composition on a selected area without touching the semi-solid emollient composition with any fingertips” (emphasis added). Furthermore, the Arquette and Miller references may not be properly combined since there is nothing in their disclosures that would teach combination or any reason for it; moreover, the combination of the proposed references would destroy the inventive technology disclosed in the Miller reference for its intended purpose as discussed *vide supra*. See, for example, *Ex parte Sternau*, 155 USPQ 733 (POBA 1967). Accordingly, Applicants respectfully request that the Examiner withdraw the § 103(a) rejection of claim 24.

Inasmuch as claims 25-31 depend from, further limit and incorporate all of the elements and limitations of claim 24, these claims are also allowable over the cited art. Applicants therefore submit that claims 25-31 are allowable and respectfully request that the Examiner withdraw the § 103(a) rejections of the same.

CONCLUSION

The cited references have been reviewed and are not believed to affect the patentability of the claims as amended. Claims 1-4, 6, 8-15 and 17-31 are pending in the application. Reconsideration of previously pending claims 1-4, 6, 8-15 and 17-31 and allowance of all claims 1-4, 6, 8-15 and 17-31 is earnestly requested.

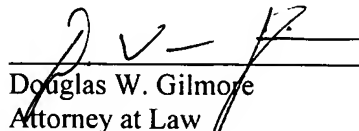
No amendment made herein was related to the statutory requirements of patentability unless expressly stated; rather any amendment not so identified may be considered as directed *inter alia* to clarification of the structure and/or function of the invention and Applicants' best mode for practicing the same.

Additionally, no amendment made herein was presented for the purpose of narrowing the scope of any claim, unless Applicant has affirmatively argued that such amendment was made to distinguish over a particular reference or combination of references. Furthermore, no election to pursue a particular line of argument was made herein at the expense of precluding or otherwise impeding Applicant from raising alternative lines of argument later during prosecution, appeal or litigation. Applicant's failure to affirmatively assert specific arguments is not intended to be construed as an admission to any particular point raised by the Examiner.

Should the Examiner have any questions regarding this Response and Amendment or feel that a telephone call to the undersigned would be helpful to advance prosecution in this matter, the Examiner is invited to call the undersigned at the number given below.

Respectfully submitted,
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Date: 02/28/2005



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